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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,497	08/05/2003	Martin Grohman	34192	8665
7590 Hovey Williams LLP Suite 400 2405 Grand Blvd. Kansas City, MO 64108		03/21/2007	EXAMINER CANFIELD, ROBERT	
			ART UNIT 3635	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE		DELIVERY MODE	
3 MONTHS	03/21/2007		PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/634,497	GROHMAN, MARTIN	
	Examiner	Art Unit	
	Robert J. Canfield	3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 29 December 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-4 and 6-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-4 and 6-20 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/10/06, 10/31/06, 2/23/07</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ |

1. This Office action is in response to the amendment filed 12/29/06. Claims 1-4 and 6-20 are pending.
2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the language "generally rounded longitudinal groove" is not in the specification. The specification never defines the grooves are being generally rounded.
3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
4. Claims 11-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The groove height is never defined in the specification and the specific dimensional ranges claimed are not provided in Table 1 as applicant asserts.
5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1-4 and 6-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over USP 5,394,667 to Nystrom.

See the embodiment of figure 12 that provides boards having upper and lower lips of substantially equal height separated by grooves 51 where the upper lips extend further from the deepest portion of the grooves and the upper lips have a rounded distal portion. As to claim 11 elements 40 are considered the joists and the groove height is considered to be the height at which the groove is spaced from the bottom of the board which is clearly shown at least about ten percent of the height of the board. As to claims 10 and 16, the process in which an article is produced need not be met in an article claims as long as all of the claimed structure is provided in the prior art.

Nystrom provides each of the elements in figure 12 except for specifying the dimensional limitation and that the board 50 is made from a composite material of cellulosic fibers and plastic.

The examiner takes Official Notice that making boards of conventional lumber type dimensions from a composite material of cellulosic fibers and plastic is well known and that it would have been obvious at the time of the invention to one having ordinary skill in the art that the boards of Nystrom could have been out of such material. It would have been obvious to make the boards out of a composite for environmental reason and because such boards are less susceptible to decay and rot.

Each of the recited dimensional limitations claimed are viewed as choices of design which would have been obvious at time of the invention to one having ordinary skill in the art particularly in view of the fact both the instant invention and Nystrom relate to decking boards and Nystrom recites that the features of his invention are applied to conventionally dimension lumber products which have a thickness which falls within the 0.5 to 2 inches. Figure 12 would suggest that the upper lip extends at least about 20% further than the lower lip and a slight spacing would be desirable to allow for water to run off and thus not accumulate upon the surface of the deck.

Nystrom fails to provide that the grooves 51 are generally rounded. The examiner takes Official Notice that it is a well known engineering concept to round internal corners to reduce stress concentrations and reduce the chances of cracking at sharp angles. It would have been obvious at the time of the invention to one having ordinary skill in the art that the grooves of Nystrom could have been rounded to reduce the chances of the boards cracking at the internal corners. It further would have been an obvious choice of design to have rounded the corners because applicant fails to provide any criticality to this feature.

7. Applicant's arguments filed 12/29/06 have been fully considered but they are not persuasive.

Applicant argues that Nystrom fails to teach rounded grooves. This feature has been addressed in the above new grounds of rejection as an obvious choice of

design for both common engineering practices and because there is no criticality of the feature disclosed.

Applicant argues that Nystrom fails to teach the groove having a height of at least about ten percent of the board height. This is not found persuasive because the groove height is not defined and the examiner has made a reasonable interpretation of what one of ordinary skill in the art could consider a groove height.

8. The supplemental IDS's filed 10/10/06, 10/32/06 and 02/23/07 have all been considered. Initialed copies of the 1449 forms are attached.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert J. Canfield whose telephone number is 571-272-6840. The examiner can normally be reached on M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Friedman Carl can be reached on 571-272-6842. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Robert J Canfield
Primary Examiner
Art Unit 3635

03/09/07

